



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: GILON=1

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| In re Application of: |) | Art Unit: 1639 |
| |) | |
| Chiam GILON |) | Examiner: J. Epperson |
| |) | |
| Appln. No.: 10/034,212 |) | Washington, D.C. |
| |) | |
| Filed: January 3, 2002 |) | Confirmation No. 7766 |
| |) | |
| For: NEW HETEROCYCLIC COMPOUNDS, |) | March 30, 2004 |
| METHOD OF DEVELOPING NEW... |) | |

REPLY TO PAPER NO. 4

Customer Window, Mail Stop
Honorable Commissioner for Patents
U.S. Patent and Trademark Office
2011 South Clark Place
Crystal Plaza Two, Lobby, Room 1B03
Arlington, Virginia 22202

Sir:

Applicant is in receipt of the Office Action mailed September 30, 2003, entirely in the nature of restriction and election requirements, and applicant hereby responds along with the submission of a petition for five months' extension of time and the five months' late fee.

The PTO has required restriction among what the examiner considers to be ten (10) patentably distinct inventions as outlined on page 2 and 3 of Paper No. 4. As applicant must make an election even though the requirement is traversed, applicant hereby respectfully and provisionally

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elects Group I, presently claims 1-11 and 20, with traverse and without prejudice.

First, the requirement is extremely burdensome to the applicant, indeed onerous. With respect, it is evident that the present applicant should not be required to file a minimum of nine (9) additional U.S. patent applications, and possible more taking into account the additional election requirements in the Office Action, when it is considered how interrelated all aspects of the present invention are. Certainly, the PTO can combine some groups to reduce the burden on the applicant.

In conjunction with what is stated in the preceding paragraph, applicant respectfully refers to and relies on the second paragraph of MPEP 803 which **requires** an examiner to search and examine plural inventions, even though the requirement is correct, if it would not constitute a "serious burden" to do so. Applicant in this regard respectfully notes that Groups VIII, IX, and X are classified in the same location as the elected Group I, i.e. there is no separate classification and therefore no "serious burden". Therefore, at the very least, the claims of Groups VIII through X should be examined along with the claims of elected Group I.

In addition, if the compounds of Group I are found to be patentable, it should follow that at least the

compositions of Group III and the various uses called for in the claims of Groups IV through X should also be patentable, therefore bringing about re-joining of such groups and allowance of the claims of those groups. Therefore, applicant further requests rejoining after the examiner has had the opportunity to evaluate the claimed compounds.

In addition to the restriction requirement, the PTO has required an election of patentably distinct "ring" structures. Again, as applicant must make an election even though the requirement is traversed, applicant hereby provisionally and respectfully elects the scaffold structure denoted as scaffold IV (see for example page 29), with traverse and without prejudice.

Seemingly as part of the same election, the PTO has required applicant to specify each of X, Y, B, Z, A, W, m and n, but that this is said to **not** be a species election requirement. Again, as applicant must fully reply, even though the requirement is traversed, applicant respectfully and provisionally elects X and Y = S; Z is -C(O); W is a direct bond; A is N(COR⁸)CHR⁷; B is -N(CGR⁶CO-L) and m and n are 6.

Again, the requirement is onerous, bearing in mind that applicant's invention is generic. Certainly the PTO can proceed in such a way as to avoid the necessity for the applicant to have to file many divisional applications to

cover his invention. Certainly generic groups can be defined which do not impose such a burden on the applicant, and yet also would not impose a serious burden on the examiner, thereby bringing into play the second paragraph of MPEP 803, upon which applicant respectfully relies.

Next, the Office Action includes a third requirement, i.e. a requirement for election of species. As applicant has elected Group I, the Office Action requires that applicant further elect a species of the scaffold-based compound. As applicant must make an election even though the requirement is traversed, applicant hereby elects the compound (see table 1 on page 40) wherein R⁶ and R⁷ are each benzyl and R⁸ is Z which is benzyloxycarbonyl. Please note the formula on page 31 of the final product which corresponds to scaffold IV.

The requirement is traversed for exactly the same reasons as indicated above, i.e. it creates an unreasonable burden on the applicant, and it would not cause a serious burden to the PTO to examine additional compounds which share the same overall configuration.

As a fourth requirement, the PTO has required applicant to list all of the claims which read on the elected species. These claims are claims 1-8, 11-24, and 28-34.

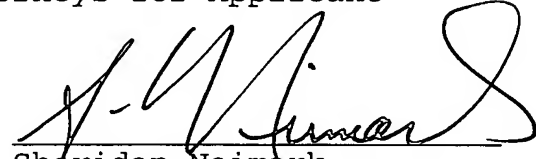
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Amd. dated March 30, 2004
Reply to Office Action of September 30, 2003

Applicant respectfully requests favorable reconsideration, including preferably withdrawing the restriction and election requirements, or at the least reconstituting same so as to reduce the burden on applicant.

Respectfully submitted,

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Attorneys for Applicant

By

A handwritten signature in dark ink, appearing to read 'S. Neimark', written over a horizontal line.

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